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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,545	06/30/2003	Jeffrey E. Koziol	40476A	7271
1609	7590	04/13/2005	EXAMINER	
ROYLANCE, ABRAMS, BERDO & GOODMAN, L.L.P.			BLANCO, JAVIER G	
1300 19TH STREET, N.W.			ART UNIT	
SUITE 600			PAPER NUMBER	
WASHINGTON,, DC 20036			3738	

DATE MAILED: 04/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/608,545

Applicant(s)

KOZIOL, JEFFREY E.

Examiner

Javier G. Blanco

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 41-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 41-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Applicant's cancellation of claims 23-40 and 52-67 in the reply filed on January 21, 2005 is acknowledged.
2. Applicant's amendment of claims 41, 43, 44, and 49 in the reply filed on January 21, 2005 is acknowledged.
3. The PTO Paralegal approved the Terminal Disclaimer filed on January 21, 2005.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 42 and 48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. Regarding claim 42, "the optical axis of the eye" (see line 2) lacks antecedent basis.
- b. Regarding claim 48, the limitation "placing the first and second lenses laterally adjacent one another" (see lines 2-3) is vague and confusing, rendering claim 48 indefinite. According to independent claim 41, the second lens is concentric with the first lens. The term "concentric" is generally defined as "having a common axis" and "having a common center". To place a first lens laterally adjacent to a second lens means that one lens is not concentric to the other lens.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

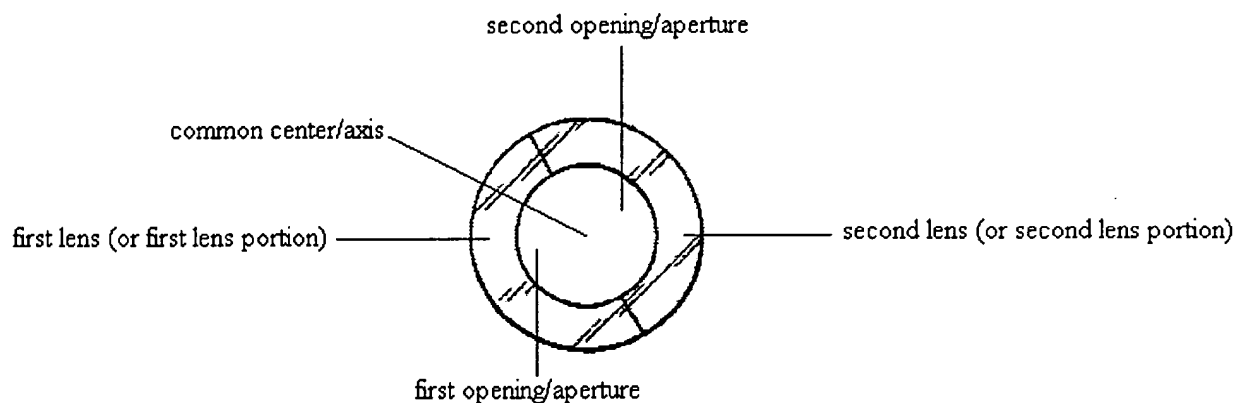
7. Claims 41-43, 49, and 50 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Peyman (US 5,964,748 A; cited in Applicant's IDS).

Referring to Figures 1-85 (particularly 82-89), Peyman discloses several methods for modifying a live cornea to correct a patient's vision. Basically, said method comprises (i) separating a portion of the cornea to form first and second internal surfaces (see corneal flap), (ii) placing a first lens (see Figures 83 and 84: ocular implant 1130" comprises two or three pieces, each one with an aperture/opening; see column 29, lines 1-11) having a first opening therein between the first and second internal surfaces, the first opening being substantially centered about the optical axis, the first lens having a first inner wall defined by the first opening, a first outer wall, and a thickness between about one and about 50 microns (see column 17, lines 32-41), and (iii) placing a second lens (see Figures 83 and 84: ocular implant 1130" comprises two or three pieces, each one with an aperture/opening; see column 29, lines 1-11) having a second opening therein between the first and second internal surfaces, the second opening being substantially centered about the optical axis and concentric with the first lens, the second lens having a second inner wall defined by the second opening, a second outer wall, and a thickness between about one and about 50 microns (see column 17, lines 32-41). The term "concentric" is

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generally defined as “having a common axis” and “having a common center”. See Peyman’s Figure 83 below.

As part of the different embodiments, the ocular implant could be a ring-shaped lens (see Figures 41, 42, 60, 61, and 82-84; see column 17, lines 32-41). Peyman further adds that the ocular implant could consist of a plurality of ocular implants (see column 18, lines 11-14). Said lens or lenses has a refractive index different or similar to the one of the cornea (see column 17, line 66 to column 18, line 3; column 19, lines 4-9).



Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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9. Claims 44-46, 48, and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peyman (US 5,964,748 A; cited in Applicant's IDS).

Peyman discloses the invention as claimed (see 102(b) rejection above). Peyman does not particularly disclose the claimed lens thickness of about 2-3 microns. However, Peyman also discloses that his/her method could be performed "without modifying the curvature of the cornea" (see column 21, lines 12-16 and lines 59-67; column 22, lines 38-42) and also that the lens (or lenses) is "very thin, i.e., as thin as paper or thinner" in order to retain the original shape of the exterior surface of the cornea even after the ocular implant or material is inserted into the cornea (see column 22, lines 38-42). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a microscopic lens with a thickness as claimed in order to retain the original shape of the exterior surface of the cornea even after the ocular implant or material is inserted into the cornea.

Also, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the lenses with a particular diameter (e.g., about 1mm) and/or thickness (e.g., about 2-3 microns thick) since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

10. Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Peyman (US 5,964,748 A; cited in Applicant's IDS) as applied to claims 44 and 46 above, and further in view of Kaufman (US 6,228,113; cited in Applicant's IDS).

Peyman discloses the invention as claimed (see 102(b) rejection above). Peyman does not particularly disclose the claimed diopter power of the lenses. However, Kaufman teaches using

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60 lenses with power intervals from +5D to -5D at 0.25D intervals in order to improve/correct a patient's visual disorder (see column 3, lines 30-45). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teaching of using 60 lenses with power intervals from +5D to -5D at 0.25D intervals, as taught by Kaufman, with the method of Peyman, in order to improve/correct a patient's visual disorder.

Also, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the lenses with a particular dioptric/diopter power (e.g., +1 to +3) since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Response to Arguments

11. Applicant's arguments with respect to claims 41 and 49 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Javier G. Blanco whose telephone number is 571-272-4747. The examiner can normally be reached on M-F (7:30 a.m.-4:00 p.m.), first Friday of the bi-week off.

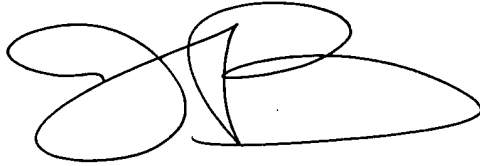
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone numbers for the organization where this application or proceeding is assigned is 703-872-9306 for regular

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communications and After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

JGB

April 8, 2005

A stylized handwritten signature consisting of large, overlapping loops and a vertical stroke.A handwritten signature in cursive script, appearing to read 'D. Willse'.

David H. Willse
Primary Examiner